



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,583	08/27/2001	Wataru Sasaki	32739M058	2723

7590 04/21/2006

SMITH, GAMBRELL & RUSSELL, LLP  
Suite 800  
1850 M Street, N.W.  
Washington, DC 20036

EXAMINER

BRUCKART, BENJAMIN R

ART UNIT	PAPER NUMBER
----------	--------------

2155

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/938,583	Applicant(s) SASAKI ET AL.	
	Examiner Benjamin R. Bruckart	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **Detailed Action**

Claims 1, 6-9 are pending in this Office Action.

Claim 1 is amended.

Claims 2-5, 10-15 are cancelled.

### **Response to Arguments**

Applicant's arguments filed 3/20/06 have been considered but are moot in view of the new ground(s) of rejection.

**Claims 1, 9 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,480,884 by Saito in view of U.S. Patent No. 6,167,251 by Segal et al.**

Regarding claim 1, a push type scanner apparatus capable of transmitting image data over a network to any of a plurality of data processing apparatus, at least multiple of the data processing apparatus having address book data set therein, said scanner apparatus (Saito: col. 2, lines 50-60; col. 3, lines 42-48) comprising:

- an original scanner for reading an original set in the push type scanner apparatus and outputting image data of an image on a surface of the original (Saito: col. 2, lines 50-60),

- a network connecting interface for connecting the push type scanner apparatus to the network (Saito: col. 5, lines 30-32),

- an address specifying means for specifying a destination address designating a destination for transmitting the image data through the network (Saito: col. 6, lines 1-4),

- a mail creating means for creating a mail to be transmitted to the address specified by the address specifying means (Saito: col. 6, lines 26-32),

- an appended file creating means for creating, when the original is read by the original scanner, an appended file comprising the image data of the original to be appended to the mail created by the mail creating means (Saito: col. 5, lines 37-57),

a transmission executing means for outputting the created mail and the appended file through the network connecting interface to the network (Saito: col. 4, lines 56-61).

The Saito reference fails to teach retrieving address book data from a network device.

However the Segal reference teaches an address book data obtaining means for obtaining obtained address book data from a predetermined one of the data processing apparatus (Segal: col. 34, lines 22-30) in response to user data and a password entered by a user (Segal: col. 29, lines 61-63), wherein the address specifying means specifies an address from the obtained address book data as the destination address (Segal: col. 29, lines 45-63) in order to link the address data with the device for quickly addressing a transmission (Segal: col. 29, lines 45-63).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create the apparatus capable of transmitting image data through a network as taught by Saito to include retrieving address book data as taught by Segal in order to link the address data with the device for quickly addressing a transmission (Segal: col. 29, lines 45-63).

Regarding claim 9, a push type scanner apparatus as claimed in claim 1, further comprising a set expression storing means for storing set expressions used for creating a text writing of a mail (Saito: col. 5, lines 37-58).

**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,480,884 by Saito in view of U.S. Patent No. 6,167,251 by Segal et al in further view of U.S. Patent No. 5,893,101 by Balogh et al.**

Regarding claim 6, the Saito reference teaches a push type scanner apparatus as claimed in claim 1 with data input means. The Saito reference fails to teach additional data input means for database processing.

However, the Balogh reference teaches an additional data inputting means for inputting additional data to be added to image data for database processing (Balogh: col. 3, lines 11-43) in order to select images using a natural language search capacity (Balogh: col. 1, lines 46-54).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create an image data transmitting and receiving system as taught by Saito and Segal to include

additional data inputting means as taught by Balogh in order to allow users to select and search images using a natural language search (Balogh: col. 1, lines 46-54).

**Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,480,884 by Saito in view of U.S. Patent No. 6,189,026 by Birrell et al in further view of U.S. Patent No. 6,321,267 by Donaldson.**

Regarding claim 7, the Saito reference teaches a push type scanner apparatus as claimed in claim 1, further comprising a store means for storing the destination addresses (Saito: col. 5, lines 19-20). The Saito reference fails to teach limiting transmission based on address.

However, the Donaldson reference teaches data transmission is limited on the basis of the domain name of each of the said destination addresses (Donaldson: col. 3, lines 34-51), and a transmission limiting means for limiting image data transmission to a destination address by corresponding the domain name of the destination address to the domain names stored in the store means (Donaldson: col. 7, lines 30-40) in order to filter out security risks and protects resources (Donaldson: col. 7, lines 66- col. 8, lines 6).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create an image data transmitting and receiving system as taught by Saito and Segal to include limiting transmission as taught by Donaldson in order to filter out security risks and protect resources.

Regarding claim 8, the Saito and Segal references teach a push type scanner apparatus as claimed in claim 1, further comprising a storing means for storing the destination addresses (Saito: col. 5, lines 19-20). The Saito and Segal references fail to teach permitting transmission based on the domain. However the Donaldson reference teaches image data transmission is permitted on the basis of the domain name of each of the said destination addresses (Donaldson: col. 3, lines 34-51), and a transmission permitting means for permitting the image data transmission to a destination address by corresponding the domain name of the destination address to the domain names stored in the storing means (Donaldson: col. 7, lines 41-50) in order to filter out security risks and protects resources (Donaldson: col. 7, lines 66- col. 8, lines 6).

It would have been obvious at the time of the invention to one of ordinary skill in the art to create an image data transmitting and receiving system as taught by Saito and Segal to include limiting transmission as taught by Donaldson in order to filter out security risks and protect resources.

### Remarks

Applicant has amended claim 1, the only independent claim to clarify that each apparatus having address book data and the address book data is obtained from a predetermined one of the apparatuses.

The examiner has read all the arguments but the claimed limitations are much broader than the arguments, therefore applicant is arguing unclaimed limitations. Specifically Page 5 of the last received amendment argues the scanner can access the address book of any PC and that they will contain personal address books and the user can get his own address book. The claimed limitation states "obtaining from a predetermined one of the apparatuses in response to the user data and password." The claimed limitation is broad and doesn't state retrieving a an address book from a user's PC. The 'predetermined one of the apparatuses' is also in question since this could be a server and the apparatus is not directly linked with the user's PC, only the user's authentication. Applicant is encouraged to produce these arguments in claim limitations as argued with support from the specification.

In response to applicant's arguments, the recitation transmitting "to any of a plurality of data processing apparatus, at least multiple of the data processing apparatus having address book data set there" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin R. Bruckart whose telephone number is (571) 272-3982. The examiner can normally be reached on 9:00-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin R Bruckart  
Examiner  
Art Unit 2155

brb



SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER